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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/21/2005

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23373 7590 11/06/2009
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EXAMINER

CHANG, CELIA C

ART UNIT

PAPER NUMBER

1625

NOTIFICATION DATE

DELIVERY MODE

11/06/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTO@SUGHRUE.COM
PPROCESSING@SUGHRUE.COM

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DETAILED ACTION

1. Amendment and response filed by applicants dated July 14, 2009 have been entered. Claims 4 and 21 are pending. Claims 9-12 have been canceled. Claims 1-3, 5-8, 13-20 stayed withdrawn from consideration.

2. Claims 4 and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

The amendment of claim 4 and 21 are considered NEW MATTER.

It is noted that the affidavit filed by Erik Fischer was based on the newest development within the area of analysis techniques which cannot be relied upon as enablement for the claims. In re Hogan 194 USPQ 507; In re Glass 181 USPQ 31.

Please note that enablement must be completed as of the time of filing and cannot be relied on or supplemented by the advancing level of skill in the art subsequent to application date.

In the affidavit no information as to what material was employed for the new measurement, what error was discovered at what time and why the specification as originally filed included the currently claimed product within its four corners. Please note that the product as originally disclosed in claim 4 is DL lactate hemihydrated having the XRD of claim 4. There is no evidence that any error in identifying the "chemical identity" of this product. Please note the Seddon reference for record which evidenced that level of ordinary skill in the art is that *"there should never be any double as to their chemical identity"*.

3. The amendment to the specification filed July 14, 2009 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added

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material which is not supported by the original disclosure is as follows: Raloxifene DL lactate anhydrous or Raloxifene L-lactate anhydrate.

Applicant is required to cancel the new matter in the reply to this Office Action.

Correction of specification cannot be based on new development in techniques. No evidence can be found in the declaration that when, how and what error occurred and when, how and what error was found with factual record to support any correction.

4. A claim to the priority benefit cannot be granted since no antecedent basis for the currently amended claims are found in the priority documents.

5. The rejection of claims 4 under 35 USC 112 second paragraph, first paragraph are maintained when the new matter is removed and the claim is restored to its original version.

In addition, there is no factual support for attorney's argument that "*the two enantiomers coexist as pairs in the same unit cell of the crystal lattice*". No unit cell information was provided, even the chemical identity or the molecular formula was not affirmed by the declaration.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang, Ph. D. whose telephone number is 571-272-0679. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet L. Andres, Ph. D., can be reached on 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OACS/Chang
Nov. 2, 2009

*/Celia Chang/
Primary Examiner
Art Unit 1625*